

2C



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,276	12/15/2000	David R. Holmes JR.	07039-197001/Side Branch	8127

7590 10/03/2002

FISH & RICHARDSON P.C., P.A.  
60 SOUTH SIXTH STREET  
SUITE 3300  
MINNEAPOLIS, MN 55402

EXAMINER

BUI, VY Q

ART UNIT PAPER NUMBER

3731

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

**Office Action Summary**

Application No.

09/736,276

Applicant(s)

HOLMES ET AL.

Examiner

Vy Q. Bui

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/16/2002 (Election of species).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 10-14, 24-27 and 29-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-23, 28 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Claims 10-12, 24-26 (Fig. 14), claims 13-14, 27, 30-31 (Figs. 17-19) withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species as shown in Figs. 14, 17-19, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

Notice that the applicants did not provide any evident to prove that four different species as shown in Fig. 5, 14, 17, 19 as indicated in the previous "Office Action" (paper 5) are obvious variations of each other. Therefore, it is proper to consider the inventions in Figs. 5, 14, 17 and 19 as distinct inventions.

Since the applicants elected the species as shown in Fig. 5, all claims (claims 10-14, 24-27, and 30-31) related to non-elected species as shown in Figs. 14, 17 and 19 are excluded in the following consideration.

A new search focused on the elected species (Fig. 5) has been conducted for the claims related to the elected species.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4 recites the limitation "the shaft" in lines 2 of each claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9/29  
OK

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2, 15-16, 28-29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by GINSBURG et al (4,769,005).

As to claims 1-2, 15-16, GINSBURG (Fig. 1-5; abstract) discloses a catheter shaft 12 having four lumens 20/22/24/26 communicating to four openings 32/34/28/36 respectively (column 3, lines 14-41) for guiding guidewires into an artery and a branch vessel (Fig. 5). GINSBURG (column 4, lines 1-3) also discloses using radiopaque markers 54 adjacent to lateral exit openings 32/34/36 for locating the openings and the catheter.

As to claims 28-29 and 32, GINSBURG (Fig. 5; abstract; claims 11-12 and 14) discloses a catheter shaft 12 having four lumens 20/22/24/26 communicating to four openings 32/34/28/36 respectively (column 3, lines 14-41) and radiopaque markers for

guiding guidewires into an artery and a branch vessel and inherently discloses a method of using the catheter as recited in the claims.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-9 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over GINSBURG et al (4,769,005) in view of MUKHERJEE (6,022,342).

As to claim 3 and 17, GINSBURG discloses substantially all structural limitations as recited in the claim, except for radiopaque markers 54 including at least one stud attached to the catheter shaft. MUKHERJEE (Fig. 2; column 5, lines 23-27) shows lateral opening 42 placed in the middle of two radiopaque markers 43 and 45 for easy identifying the lateral opening 42 as compared to Fig. 8 of the present invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place GINSBURG openings 32/34/36 in the middle of radiopaque markers 54 as recited in the claims, as this configuration would facilitate identifying the openings 32/34/36 during a surgical procedure.

As to claims 4-9 and 18-23, GINSBURG discloses substantially all structural limitations as recited in the claims, except for different designs of the radiopaque markers as claimed. It would have been an obvious matter of design choice to modify

Art Unit: 3731

GINBURG radiopaque markers as claimed. It appears that the GINSBURG catheter and the catheter as described in the present invention would perform equally well with any design of radiopaque markers as long as the markers are placed adjacent to a lateral opening to help a surgeon to locate the lateral opening.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



VQB

September 29, 2002.